

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)
Frank et al.) Confirmation No.: 7629
)
Serial No.: 09/750,154) Group Art Unit: 3629
)
Filed: December 29, 2000) Examiner: Ouellette, Jonathan P.
)
For: System and Method for Determining) Docket No.: 190252-1190
The Marketability of Intellectual Property)
Assets)

COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Statement of Reasons for Allowance includes some broad conclusory statements that may be viewed as an oversimplification of the examination issues, and if taken out of context, could give rise to an improper interpretation of the claims as well as the file history. For these reasons, Applicants provide the following comments.

First, Applicants assert that there are multiple grounds supporting allowance of the presently pending claims, including grounds not stated in the Statement of Reasons for Allowance.

Second, in accordance with 35 U.S.C. Section 282: "Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim." Thus, any dependent claims that are not addressed by the Statement of Reasons for Allowance should not rise or fall, when construed in terms of validity, with their

respective independent claims, but instead should be construed independently of their respective independent claims.

Third, the scope and validity of each claim (whether in independent, dependent, or multiple dependent form) should be determined based upon the entire combination of elements/features/steps in each claim, as opposed to only the particular elements/features/steps pointed out by the Statement of Reasons for Allowance if such elements/features/steps are not inclusive of all claimed elements.

Fourth, the Statement of Reasons for Allowance states that, with respect to claims 11 and 48, “the prior art does not teach or suggest ... completing a marketing opportunity assessment on only the *intellectual property rights* (not an actual product or service), as claimed by the independent claims.... Hunter fails to expressly disclose completing a marketing opportunity assessment on only the *intellectual property rights* (not an actual product or service), as claimed by the independent claims.” (emphasis in original) Applicants interpret the quoted text to merely distinguish between rights and “an actual product or service,” with respect to these particular claims, and that the claims do not require completing a marketing opportunity assessment on actual products or services. However, since the pending claims are open-ended (including the word “comprising”), the claims clearly do not prohibit such additional elements, i.e., completing a marketing opportunity assessment on actual products or services. Applicants respectfully request notification of any contrary conclusions or interpretations.

Fifth, the Statement of Reasons for Allowance states that, with respect to claims 35 and 41, “the prior art does not teach or suggest ...managing marketing of a plurality of *intellectual property rights assets*, the method comprising, determining a market value for intellectual property rights assets; and generating a marketing project plan with a schedule of marketing tasks for the at least one intellectual property rights asset, based on both a template plan and on the determined market value (analyzing and developing a marketing plan for IP rights – not IP innovations or products)... Hunter fails to expressly disclose completing a marketing opportunity assessment on only the *intellectual property rights* (not an actual product or service), as claimed by the independent claims.” (emphasis in original) Applicants first repeat the distinction noted

above regarding claims 11 and 48. In addition, Applicants also submit that limitations discussed above regarding claims 35 and 41 are not found in claims 35 and 41. Consequently, Applicants request the Examiner to issue new Reasons for Allowance.

Respectfully submitted,

/CWG/

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Date: August 8, 2007

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Docket: **190252-1190**